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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/768,967	01/30/2004	Sven Schwerin-Wenzel	14413-027001 / 2003P00109	4556
54975 7590 06/11/2007 HOLLAND & KNIGHT LLP 10 ST. JAMES AVENUE 11th Floor BOSTON, MA 02116-3889			EXAMINER TANK, ANDREW L	
			ART UNIT 2173	PAPER NUMBER
			MAIL DATE 06/11/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/768,967

Applicant(s)

SCHWERIN-WENZEL ET AL.

Examiner

Andrew Tank

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 August 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>04/20/2006</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This action is in response to the original filing of January 30, 2004. Claims 1-24 are pending and have been considered below.

#### ***Claim Objections***

1. Claims 1-24 are objected to because of the following informalities: grammar and punctuation. The above claims have several punctuation errors which changes the grammar (examples include claim 3 lines 7-8, claim 6 line 4, claim 18 line 6). Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 5 and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claim 5: In lines 4-5, applicant recites “a security of the user interface related to the phase of the merger and a role of the user.” It is unclear whether “a security” involves a physical security force, a username/password combination, a special encryption method, or any other number of security measures one of ordinary skill in the art at the time the invention was made would apply to protect a graphical user interface. The examiner will interpret this as

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being a read-only/edit system relating to predefined accessibility levels proportional to the role of the user and the phase of the merger.

- Claim 9: In line 2, applicant recites “a first tool adapted to retain one or more customers”. It is unclear whether it is the customers’ records being retained, their accounts, or their satisfaction levels. As the tool is acted through a program, it would be incredulous to retain the customers themselves. Claim 10 is a child claim of claim 9 and is therefore further rejected.

***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 8-17, and 22-24 are rejected under 35 U.S.C. 101 because the claimed inventions are directed to non-statutory subject matter.

- Claims 8-10 are drawn to a system comprising a software process housed in a medium. The medium could be paper. The examiner has determined this structural limitation is not a series of steps or acts and is not a process. A program written on paper is not a physical article or object and as such is not a machine or manufacture. A program written on paper is not a combination of substances and therefore not a compilation of matter. Thus, a program written on paper by itself or in combination does not fall within any of the four categories of invention. Therefore, claims 8-10 are not statutory.
- Claims 11-14 are drawn to a system including a software product. A software product is not a series of steps or acts and is not a process. A software product is not a physical article or

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object and as such is not a machine or manufacture. A software product is not a combination of substances and therefore not a compilation of matter. Thus, a software product by itself or in combination does not fall within any of the four categories of invention. Therefore, claims 11-14 are not statutory.

- Claims 15-17 are drawn to a system comprising a graphical user interface. The examiner has determined this graphical user interface to be a combination of computer program modules. Therefore, the system involved is a system of computer program modules. A computer program module is not a series of steps or acts and is not a process. A computer program module is not a physical article or object and as such is not a machine or manufacture. A computer program module is not a combination of substances and therefore not a compilation of matter. Thus, a computer program module by itself or in combination does not fall within any of the four categories of invention. Therefore, claims 15-17 are not statutory.
- Claims 22-24 are drawn to a system comprising a services unification module. The examiner has determined this services unification module to be a combination of computer program modules. Therefore, the system involved is a system of computer program modules. A computer program module is not a series of steps or acts and is not a process. A computer program module is not a physical article or object and as such is not a machine or manufacture. A computer program module is not a combination of substances and therefore not a compilation of matter. Thus, a computer program module by itself or in combination does not fall within any of the four categories of invention. Therefore, claims 15-17 are not statutory.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-16 and 18-24 are rejected under 35 U.S.C. 102(e) as being unpatentable by

**Marpe et al.** (U.S. Patent 6,671,692).

- **Claim 1: Marpe et al.** disclose a method comprising:
  - presenting a user interface including information (col 10 lines 27-29, col 17 lines 44-58) relating to consolidating customer accounts for at least one of two or more organizations involved in corporate restructuring (col 9 lines 34-37, col 10 lines 17-21, col 18 lines 35-57); and
  - presenting a template in the user interface (col 34 lines 9-67, col 35 lines 1-12), the template including a rollout template menu, a pull down window, a list of action items, and a status relating to each action item in the list (col 34 lines 36-65, Table 24).
- **Claim 2: Marpe et al.** disclose the method as in claim 1 above, wherein the list of action items comprises at least one of an account executive assignment notification, an account executive personalized communication, a customer communication, a cross selling opportunity, a retention plan (col 34 Table 24), and an action including a transmission of an email (col 18 lines 53-57 Issue Resolution Screen).

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- Claim 3: **Marpe et al.** disclose a method comprising:
  - providing a single logical physically distributed information system across one or more information systems of at least two enterprises being combined (col 9 lines 22-40); and
  - providing a user interface to allow a user to access the single logical physically distributed information system to execute one or more pre-merger activities, merger activities and post-merger activities (col 10 lines 6-36); the merger activities including customer-related integration and resources, the post-merger activities including a post-merger assessment and a measurement of one or more achieved merger synergies (col 53 lines 31-67, col 54 lines 1-67, col 55 lines 1-19).
- Claim 4: **Marpe et al.** disclose the method as in claim 3 above, wherein the merger activities further comprise:
  - providing customer-related communications (col 54 line 62); and
  - managing and planning customer support activities, the customer support activities including addressing one or more customer issues and concerns (col 53 lines 64-67, col 54 lines 1-66).
- Claim 5: **Marpe et al.** disclose the method as in claim 3 above, wherein the user interfaces are adapted to a role of the user and a phase of the merger; the user role including an executive of one or more customer accounts, a security of the user interface related to the phase of the merger and a role of the user (col 18 lines 25-34).
- Claim 6: **Marpe et al.** disclose a method comprising:

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- facilitating consolidation of customer-related information for a first organization being merged with a second organization; the customer-related information including customer accounts; the consolidation including matching one or more customer accounts of the organization; and
  - facilitating consolidation of customer-related assignments of at least one of the organizations (col 18 lines 25-67, col 19 lines 1-67).
- **Claim 7: Marpe et al.** disclose the method as in claim 6 above, further comprising:
  - providing an exception list for non-matched customer accounts (col 18 lines 56-57); and
  - tracking a status of customer related engagements (col 18 lines 65-67).
- **Claim 8: Marpe et al.** disclose a system for managing a merger of at least two organizations, wherein the system comprises a software process stored on a medium, the software process including a user interface adapted to assist customer satisfaction during a merger period (col 9 lines 22-67, col 10 lines 1-37).
- **Claim 9: Marpe et al.** disclose the system as in claim 8, further comprising:
  - a first tool adapted to retain one or more customers (col 47 lines 50-67, col 48 lines 1-20);
  - a second tool adapted to provide collaborative customer retention planning (col 47 lines 50-67, col 48 lines 1-20);
  - a third tool to provide targeted and personalized email to customers of at least one of the organizations (col 9 lines 34-37 marketing tool).



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- Claim 10: **Marpe et al.** disclose the system as in claim 9 above, wherein the second tool is adapted to provide a unified and aligned presentation of customer accounts, including customer records (col 48 lines 21-67, col 49 lines 1-67, col 50 lines 1-67, col 51 lines 1-67, col 52 lines 1-23 explanation of the two main screens of the Planning Guide application).
- Claim 11: **Marpe et al.** disclose a system for implementing a merger of at least two organizations, the system including a software product adapted to facilitate sale-related activities of the organizations; the software product including a user interface (col 9 lines 22-67, col 10 lines 1-37); wherein the sales-related activities include at least one of sales consolidation, cross selling activities, and customer retention of the organizations (col 47 lines 65-67, col 48 lines 1-20).
- Claim 12: **Marpe et al.** disclose the system as in claim 11 above, wherein the user interface presents at least one of a synergy, an expected impact, a realized impact, and a progress of the expected impact; the user interface presents the progress in a graph and at least one of an owner of the synergy, an electronic mailing link, and one or more initiatives related to the synergy (col 18 lines 25-57).
- Claim 13: **Marpe et al.** disclose the system of claim 11, wherein the user interface presents information for one or more user-identified cross selling opportunities (col 9 lines 22-67, col 10 lines 1-37, col 52 lines 30-67, col 53 lines 1-31); the information including a number of matched customer accounts, a status, and a potential value, the potential value associated with an external object (col 40 lines 40-58, col 3 lines 40-67, col 4-8, col 9 lines 1-20 Object Oriented Programming).

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- Claim 14: **Marpe et al.** disclose the system of claim 11, wherein the user interface comprises (col 47 lines 50-67, col 48-51, col 52 lines 1-29 The Planning Guide):
  - a first panel adapted to address customer-related issues (Fig. 16 “Identify Stakeholder Requirements”);
  - a second panel adapted to address sales-related initiatives; the second panel including at least one of an approval button, a rejection button, a checklist of initiatives, a number of impacted customers, a financial impact, an initiative owner, and an initiative priority level (Fig. 16 1606 “Confirm Merger/Acquisition Value”);
  - a third panel adapted to facilitate customer retention (Fig. 16 “Develop Initial Customer Retention Approach”); the third panel including a measure of customer retention, one or more retention rates, and a movement of the one or more rates;
  - a fourth panel adapted to facilitate customer retention (Fig. 16 “Develop Initial Customer Retention Approach”); the fourth panel including at least one of a customer satisfaction rate, a customer survey, and a movement of the rate; wherein the customer survey comprises one or more external objects; and
  - a fifth panel adapted to facilitate a search of merger information and to facilitate contacting one or more merger members (Fig. 16 “Search” and “Create Initial Announcement”).
- Claim 15: **Marpe et al.** disclose a system for managing a merger of at least two organizations, the system comprising a graphical user interface adapted to allow a user to consolidate customer accounts for at least one of the organizations, the graphical user

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interface further adapted to match customer accounts from at least two merger organizations (col 18 lines 25-67, col 19 lines 1-67).

- Claim 16: **Marpe et al.** disclose the system as in claim 15 above, wherein the graphical user interface comprises a sorted list of customer accounts (col 43 lines 13-67, col 44-46, col 47 lines 1-49 Contacts and Organizational Charts), a customer account value (col 43 Table 39 Title), a numerical representation of account ranking (col 43 Table 39 MemberID), information for at least one customer service personnel from each merger organization (col 45 Table 41 Owner), information for a customer service personnel assignment relating to at least one account (col 45 Table 41 Event), the customer service personnel assignment including a cooperative assignment (col 45 Table 41 Team).
- Claim 18: **Marpe et al.** disclose a method for managing a merger of at least two organizations comprising:
  - presenting a user interface including information (col 10 lines 27-29, col 17 lines 44-58) relating to consolidating accounts for at least one of the merger organizations (col 9 lines 34-37, col 10 lines 17-21, col 18 lines 35-57); the user interface including a pull down window, a text box, a trigger date, and a response date (col 20-21 Table 3); and
  - presenting a template in the user interface; the template including a notification template menu, a list of action items, and an owner relating to each action item in the list (col 34 lines 9-67, col 35 lines 1-12).
- Claim 19: **Marpe et al.** disclose the method as in claim 18 above, wherein the list of action items comprises at least one of an account executive assignment notification, an account

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executive personalized communication, a customer communication, a cross selling opportunity, and a retention plan, an action item includes transmission of an email (col 34 table 24, col 18 lines 53-57 Issue Resolution Screen).

- **Claim 20: Marpe et al.** disclose the method of claim 18 further comprising facilitating exception handling for at least one of the action items (col 34 table 24 Priority High, Medium, Low).
- **Claim 21: Marpe et al.** disclose the method of claim 18, wherein the user interface further presents at least one of a list and a graph, the graph presents a time period for each listed action (Fig. 10 1002).
- **Claim 22: Marpe et al.** disclose a system for managing a merger of at least two organizations comprising a services unification module (col 9 lines 17-67, col 10 lines 1-37); the services unification module including one or more user roles, the user roles including at least one of customers, services taskforce members, service representatives, and integration project managers (col 18 lines 26-27).
- **Claim 23: Marpe et al.** disclose a system of claim 22, wherein the services unification module comprises one or more inputs, the inputs comprising: a list of customer accounts, a list of products sold to one or more customers, a list of customer-related services, a list of customer-related personnel, and a list of service providers (col 43 lines 13-67, col 44-46, col 47 lines 1-49 Creating Contacts and Organizational Charts).
- **Claim 24: Marpe et al.** disclose a system of claim 22, wherein the services unification module further comprises one or more outputs, the outputs comprising: an account services consolidation plan, a merged account repository, a customer communication, a tracking

statistic, and a customer-satisfaction statistic (col 48 lines 21-67, col 49 lines 1-67, col 50 lines 1-67, col 51 lines 1-67, col 52 lines 1-23 explanation of the two main screens of the Planning Guide application).

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Marpe et al.** (U.S. Patent 6,671,692).

- **Claim 17: Marpe et al.** disclose the system as in claim 15 above, but does not specifically disclose a second list of customer accounts related to un-matched accounts and a clean room tool adapted for at least one stakeholder. The clean room tool, as disclosed by applicant ([0088]) is a tool used to give these stakeholders privileged access to confidential information. **Marpe et al.** does disclose the use of passwords and usernames (col 43 Table 39). **Marpe et al.** further disclose executives accessing key information (col 18 lines 25-34) and the use of criterion to sort data (col 18 line 45). Therefore, it would have been obvious to one of ordinary skill in the art that the use of usernames/passwords, accessing privileged information, and filtering data using criterion implies the necessary system structure to perform the aforementioned processes. One would have been motivated to allow executives access to key information through use of a username/password because executives must be

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able to identify and track realized benefits as well as issues securely and quickly (col 18 lines 26-38). Further one would be motivated to apply an un-matched accounts criterion to display a second list in order to provide executives with detailed information regarding the company, its financials, customers, employees and technology (col 19 lines 65-67).

### *Conclusion*

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- U.S. PreGrant Publication 2003/0018510 (Sanches) pertains to panning and managing initiatives using software.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew Tank whose telephone number is 571-270-1692. The examiner can normally be reached on Mon - Fri (Alt. Fri Off) 0730-1500 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cabeca can be reached on 571-272-4048. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

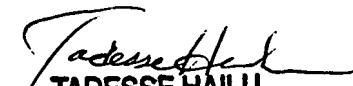
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ALT  
June 6, 2007

John Cabeca  
Supervisory Primary Examiner



**TADESSE HAILU**  
**PRIMARY EXAMINER**